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THIS DISPOSITION IS NOT
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U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

Bose Corporation
v.
Motorola, Inc.

Opposition No. 102,162
to application Serial No. 74/663,244
filed on April 19, 1995

Charles Hieken of Fish & Richardson for Bose Corporation.

David Hillard and John Murphy of Pattishall, McAuliffe,
Newbury, Hilliard & Geraldson for Motorola, Inc.

Before Cissel, Hairston and Walters, Administrative
Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

An application has been filed by Motorola, Inc.
(Motorola) to register the mark LIFESTYLE for "radio
telephones, cordless telephones, cellular telephones, radio
transceivers and accessories, namely microphones, speakers,

control units, cases, batteries, battery chargers and handsets."¹

Registration has been opposed by the Bose Corporation (Bose) on the ground that since at least as early as September 12, 1989 it has used the mark LIFESTYLE in connection with loudspeakers and/or music systems; that it is the owner of a registration for the mark LIFESTYLE for "loudspeaker systems²;" and that Motorola's mark, if used in connection with the identified goods, would so resemble Bose's mark as to be likely to cause confusion.

Motorola, in its answer, denied the salient allegations of the likelihood of confusion claim. In a counterclaim, Motorola alleges that Bose has not used the LIFESTYLE mark in connection with every type of speaker imaginable, but rather only in connection with loudspeaker systems for high fidelity music reproduction; that Motorola is damaged by Bose's registration because it may allow Bose to prevent Motorola from obtaining a registration for its mark; and that Bose's registration should be partially restricted to limit the goods therein to "loudspeaker systems for high fidelity music reproduction." Further, Motorola indicates that, if necessary to avoid a likelihood of confusion, it is

¹ Application Serial No. 74/663,244 filed April 19, 1995, alleging a bona fide intention to use the mark in commerce.

² Registration No. 1,622,251 issued November 13, 1990; Sections 8 & 15 affidavit filed.

willing to accept a limitation of the goods in its application to delete "microphones" and "speakers."

Before reciting the record herein, it is necessary to rule on two evidentiary matters. First, Bose, in its brief on the case, argues that Motorola's notice of reliance should be stricken because it was untimely submitted. Motorola filed its notice of reliance on April 21, 1997, over a month before the opening of its testimony period. In response to this argument, Motorola states that the error in filing the notice early was made in good faith and points out that no objection to the notice was raised by Bose earlier. It appears that the error in filing the notice early was made in good faith. More importantly, Bose, by waiting to raise this matter in its brief on the case, has waived its objection to the premature filing of the notice, which could have been corrected upon seasonable objection. See *Of Counsel Inc. v. Strictly of Counsel Chartered*, 21 USPQ2d 1555 (TTAB 1991).

Second, Motorola objects to the admission of testimony and documents introduced into the record during the deposition of Bose's witness, William Allen. The testimony and documents contain information regarding the volume of sales, advertising expenses and promotional efforts in connection with opposer's goods. Motorola objects on the ground that this information fell within the scope of

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several of Motorola's discovery requests to which Bose objected on the ground that the information was privileged. However, if Motorola was dissatisfied with Bose's responses, it was incumbent upon Motorola to contact Bose in an attempt to resolve the matter (preferably with a stipulated protective order), failing which Motorola should have filed a motion to compel discovery. See Trademark Rule 2.120(e) and Comserv Corporation v. Comserv, 179 USPQ 124, 125 (TTAB 19730. We should point out that at the testimony deposition the information concerning Bose's sales, advertising and promotion was introduced subject to a protective order. Thus, this is not a situation where a party, in an attempt to avoid discovery, refuses to answer interrogatories and/or produce documents on the ground of confidentiality and then turns around and provides the information openly during a testimony deposition. In view of the foregoing, the evidence has been considered.

The record consists of the pleadings; the file of the involved application; the deposition (with exhibits) of Bose's witness, William Allen; Bose's notice of reliance on Motorola's responses to certain of Bose's discovery requests and a status and title copy of Bose's pleaded registration³; and Motorola's notice of reliance on four of its

³ While Bose also submitted Motorola's answer to an allegation in the notice of opposition, this is unnecessary inasmuch as the pleadings automatically form part of the record herein.

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registrations of marks which include the term "LIFESTYLE." Motorola took no testimony and offered no other evidence.

Both parties filed briefs on the case and an oral hearing was held before the Board.

According to Bose's witness, Mr. Allen, the LIFESTYLE mark was first used by Bose on loudspeaker systems and music systems around 1990. Bose currently uses the LIFESTYLE mark to identify powered speaker systems, music systems, music centers, home theater systems, and parts and accessories for these products. Mr. Allen identified photographs of shipping cartons Bose's products are sold in to retailers such as Circuit City, Best Buy and Sears. Mr. Allen identified photographs of shipping cartons and over twenty reviews of Bose's LIFESTYLE loudspeaker systems and music systems which appeared in newspaper and trade magazines between May and October 1990. Accordingly to Mr. Allen, Bose has spent several million dollars advertising its LIFESTYLE products and its total sales have been approximately \$75,000,000. Mr. Allen testified that Bose also sells sound systems to automobile manufacturers such as Acura, Cadillac, Mercedes, Honda, and Nissan for use in their automobiles, although not under the LIFESTYLE mark. Mr. Allen testified that cellular phone systems in automobiles are used with Bose sound systems. In particular, he testified as follows:

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Q: Are Bose sound systems used with cellular phone systems in automobiles?

A: Yes.

Q: Have you actually used a cellular phone in connection with a Bose sound system?

A: Yes, I have.

Q: Could you describe that experience, please?

A: Well, I turned on the radio. We were listening to a local radio station. Then I pressed the buttons on the telephone console to dial my wife which interrupted the radio broadcast, and instead of hearing a voice on the radio, I then heard my wife's voice over the same Bose sound system.

In addition, Mr. Allen testified that Bose is considering using the LIFESTYLE mark in connection with automotive sound systems and elsewhere. However, he offered no specific information with respect to Bose's plans in this regard.

As indicated above, the only evidence submitted by Motorola are copies of its four registrations for marks which include the term LIFESTYLE: Registration No. 1,709,830 for the mark LIFESTYLE PAGER (stylized) for portable radio communications receiver (PAGER is disclaimed); Registration No. 1,983,703 for the mark LIFESTYLE for computer peripheral equipment, namely modems; Registration No. 1,991,041 for the mark LIFESTYLE SERIES for computer peripheral equipment, namely modems; and Registration No. 1,992,920 for the mark LIFESTYLE PLUS for

portable radio communications receivers and software for programming radio communication receivers.

Inasmuch as a status and title copy of Bose's registration is of record, there is no issue with respect to Bose's priority. *King Candy Co., Inc. v. Eunice King's Kitchen, Inc.*, 182 USPQ 108 (CCPA 1974). In any event, Bose's testimony establishes its prior use of the mark LIFESTYLE in connection with loudspeaker systems and music systems.

We turn then to the issue of likelihood of confusion. Bose argues that its goods, i.e., loudspeaker systems and music systems, on the one hand, and the goods identified in Motorola's application, i.e., radio telephones, cordless telephones, cellular telephones, radio transceivers and accessories, namely microphones, speakers, control units, cases, batteries, battery chargers and handsets, on the other hand, are related. In particular, Bose points out that these kinds of goods may be sold in the same retail stores to the same class of purchasers. Further, Bose argues that Motorola's counterclaim is impermissible inasmuch as Bose's registration is incontestable; and that the restriction which Motorola seeks will not eliminate the likelihood of confusion.

Motorola, on the other hand, argues that "loudspeaker systems" is an overly broad identification of goods because

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Bose has not used the LIFESTYLE mark in connection with every type of speaker imaginable, but only in connection with loudspeakers for high fidelity music reproduction; that loudspeakers for high fidelity reproduction and Motorola's products are not related; and therefore there would be no likelihood of confusion if Bose's registration is restricted. Further, Motorola maintains that its counterclaim is permissible because it is tied to the ground of abandonment, that is, Bose has not used the mark in connection with loudspeakers other than those for high fidelity music reproduction. Finally, Motorola argues that Bose cannot be damaged in the instant case because it has not objected to Motorola's other registrations which include the term LIFESTYLE.

We turn first to the issue of likelihood of confusion vis-à-vis Bose's loudspeaker systems and music systems and the goods in Motorola's application, i.e., telephones, radio transceivers, and accessories therefor. At the outset, we note that the marks of the parties are identical. The Board has stated in the past that "[i]f the marks are the same or almost so, it is only necessary that there be a viable relationship between the goods or services in order to support a holding of likelihood of confusion." In re Concordia International Forwarding Corp., 222 USPQ 355, 356 (TTAB 1983). In the present case, there are of course,

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specific differences between, on the one hand, Bose's loudspeaker systems and music systems, and on the other hand, Motorola's radio telephones, cordless telephones, cellular telephones, radio transceivers and accessories, namely microphones, speakers, control units, cases, batteries, battery chargers and handsets. However, these goods are all electronic products for sound reproduction or communication. Moreover, these goods may be sold in the same retail outlets to the same purchasers, i.e., ordinary consumers. Under the circumstances, we find that the goods are sufficiently related that, if sold under identical marks, confusion would be likely to occur among purchasers. See: In re Dynaco, Inc., 189 USPQ 104, 105 (TTAB 1975) ["It has frequently been held that products which can be characterized as electronic equipment may reasonably be expected to have been produced, offered, and or sold by the same electronic manufacturer."]; In re Instruteck Corporation, 184 USPQ 618 (TTAB 1974) [Confusion is likely if similar marks are applied to phonographs and tape recorders and to citizens band transceivers]; and In re Columbia Broadcasting System, Inc., 171 USPQ 311 (TTAB 1971) [Confusion is likely if identical mark is applied to radios and transceivers and to amplifier loudspeakers systems.] We should add that Motorola, in its brief as defendant in the opposition, does not dispute that confusion is likely

from contemporaneous use of the mark LIFESTYLE in connection with the goods identified in its application and Bose's loudspeaker systems and music systems.

We turn next to Motorola's attempt to restrict Bose's registration to loudspeaker systems for high fidelity music reproduction. As stated in *Milliken & Co. v. Image Industries Inc.*, 39 USPQ2d 1192, 1194 (TTAB 1996):

. . . the Board no longer requires that a petition for partial cancellation be tied to a ground for cancellation, but does require that a party seeking to restrict an opponent's broadly worded identification of goods, in a case involving likelihood of confusion, plead and prove (1) that entry of the proposed restriction will avoid a likelihood of confusion and (2) that the opponent is not using the mark on the goods or services that will be effectively excluded by the proposed restriction.
(citations omitted)

In this case, we agree with Bose that Motorola's proposed restriction would not serve to avoid a likelihood of confusion. Loudspeakers for high fidelity music reproduction are still electronic products and the proposed restriction does not delineate any different users or channels of trade. For the same reasons, Motorola's proposed restriction to delete speakers and microphones from its own identification of goods would not serve to avoid a likelihood of confusion. Thus, each of the proposed restrictions is denied.

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In sum, we conclude that consumers familiar with Bose's loudspeaker systems and music systems sold under the LIFESTYLE mark would be likely to believe, upon encountering Motorola's identical mark LIFESTYLE for telephones, radio transceivers, and accessories therefor, that the respective products originated with or were somehow associated with or sponsored by the same entity.

Several additional matters require comment. First, to the extent that Motorola intended to rely on the *Morehouse* defense (*Morehouse Manufacturing Corporation v. J. Strickland and Company*, 407 F.2d 881, 160 USPQ 715 (CCPA 1969)), we note that a subsisting registration may not be relied on by a defendant as a basis for contesting an attack upon another registration or application unless the mark and the goods or services shown in the subsisting registration are the same as or substantially identical to the mark and goods or services set forth in the defendant's challenged application or registration. It is clear that Motorola's four prior registrations do not involve the same or substantially identical goods as its involved application, so the asserted defense is inapplicable.

Another matter relates to Motorola's mention of the absence of any instances of actual confusion. Of course, this is an intent-to-use application and there is no indication that the mark is in use, much less evidence of

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the extent of use (e.g. sales and/or advertising figures) for the particular goods identified in the application. Thus, we do not know whether or not there has been any meaningful opportunity for confusion to occur in the marketplace.

Finally, to the extent that we have any doubt in this proceeding, we must resolve it in favor of the registrant and against applicant. *Giant Food, Inc. v. Nation's Foodservice, Inc.*, 710 F.2d 1565, 218 USPQ 390, 395 (Fed. Cir. 1983).

Decision: The opposition is sustained and registration to applicant is refused. The counterclaim for partial cancellation is dismissed.

R. F. Cissel

P. T. Hairston

C. E. Walters
Administrative Trademark
Judges, Trademark Trial and
Appeal Board

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